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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/240,062	01/29/99	GRAF	T 2565/45

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QM22/1026

EXAMINER

CHOI, S

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 10/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/240,062

Applicant(s)

GRAF ET AL.

Examiner

Stephen Choi

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The office action mailed on 31 March 2001 contains an inadvertent error by the examiner on paragraph 5. Claim 5 should have been rejected over Everhart in view of Philipp, and further in view of Hurtes since claim 1 was rejected over Everhart in view of Philipp and claim 5 depends on claim 1. However, the examiner believes that the rejection should have been clearly understood from the context of the examiner's office action, and it appears that the applicant understood as such from his remarks.

Information Disclosure Statement

2. The information disclosure statement filed 09/22/2000 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information. EP 0473064 is not in the English language and there is no indication that the submitted search report is related to the instant application. It has been placed in the application file, but EP 0473064 has not been considered.

Specification

3. The attempt to incorporate subject matter into this application by reference to EP 0411572 is improper because the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing

application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, it is not clear what step is inferred by "placing the partial bundles in a first collection trough of a collection device". Is this the same step as "placing the partial bundles in a first collection trough of a collection device" recited in claim 1?

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Everhart (US 4,044,438) in view of Philipp et al. (US 5,927,819).

Everhart discloses the invention substantially as claimed including the steps of:

- a) transporting a fiber bundle strand using at least one feed element
(e.g., 10);

- b) cutting the fiber bundle strand into partial bundles having a length (e.g., 53);
- c) releasing the partial bundles from the at least one feed element (e.g., col. 5, lines 9-18);
- d) releasing the partial bundles and placing the partial bundles in a first collection trough of a collection device (e.g., col. 5, lines 19-31).

Everhart does not disclose a step of gripping the partial bundles using at least one gripping element. Everhart device transports the partial bundles by a suction tube and release into a collection location. Philipp teaches the use of gripper to hold and transport a bundle of bristles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a gripper as taught by Philipp on the Everhart's device in order to insure binding of a cut bundle during transporting of the cut bundle to a collection location.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Everhart (US 4,044,438) in view of Philipp et al. (US 5,927,819) as applied to claim 1 above, and further in view of Hurtes (US 3,951,022).

Everhart and Philipp disclose the invention substantially as claimed except for a step of rotating the collection device after a first collection trough is filled and placing the partial bundles in further collection trough. Hurtes teaches a horizontal advancement means (12) to accommodate each oriented fibers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified device of Everhart with a plurality of rotating collection device as taught by

Hurtes in order to transport only a desired amount of fibers to a subsequent station for further processing.

Response to Arguments

9. Applicant's arguments filed 08/20/2001 have been fully considered but they are not persuasive.

With respect to claim 1, applicant contends that there is no suggestion or motivation to combine the teachings of Everhart and Philipp since Everhart is directed to an apparatus and method from forming yarn balls and Philipp seems to disclose methods and devices for trimming and rounding bristles such that the teachings of Philipp are not applicable to those of Everhart, and would not be obvious to one skilled in the art to combine. Applicant further contends that Everhart and Philipp represent non-analogous art and completely fail to teach or suggest the "cutting" step in the context recited in claim 1.

In response to the applicant's argument regarding non-analogous of the references, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Everhart reference teaches transporting of the cut bundles using both binder means and suction means and the Philipp teaches the use of gripper. Thus, the both references are reasonably pertinent to the particular problem which the applicant was concerned, that is, how to transport a bundle of strands more reliably regardless of whether the bundle is bound or not. Regarding the applicant's

argument that there is no suggestion or motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of gripper is the knowledge generally available to one of ordinary skill in the art of handling a group of strands or filaments, and the issue at hand is whether it would have been obvious to one having ordinary skill in the art to modify the device of Everhart with the teachings of Philipp in order to provide a more reliable way of transferring a group of strands. Although the device of Everhart uses a binder means to keep strands together and suction means for transporting the bundles to a collection device, the teachings of Philipp would have suggested the one having ordinary skill in the art to employ the gripper in lieu of suction means in order to insure binding of the bundle during transporting. Thus, it is deemed obvious to modify the Everhart's device with the gripper as taught by Philipp. In response to the applicant's contention regarding the "cutting" step, claim 1 merely calls for "cutting the fiber bundle strands into partial bundles, the partial bundles having a length". Everhart does teach a step of cutting strands into partial bundles wherein the partial bundles having a length. The claim does not recite any steps to preclude that the strands being bound together before the cut.

With respect to claim 5, applicant contends that the prior art references do not teach, alone or in combination, a step of "rotating the collection device after the first

collection trough is filled and placing the partial bundles in a further collection trough” since Hurtes teaches no such rotating collection device. The examiner respectfully disagree. The Hurtes references teaches a horizontal advancement means including a plurality of guides which each successive guide being incrementally positioned by a pair of rollers and index means in order for each guide to accommodate a segment of fibers. Thus, Hurtes does teach a rotating collection device as claimed, and the teachings of Hurtes would have suggested to one having ordinary skill in the art to provide a rotating collection device on the modified device of Everhart since doing so would provide a device capable of automatically collecting a desired amount of product in each of multiple collection location without interruption to the process to replace a collection location after it is filled with a new collection location.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to S. Choi whose telephone number is (703) 306-4523. The examiner can normally be reached on Monday through Friday from 9:30 AM to 3:30 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082. The fax phone number for this Group is (703) 305-3579.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Choi of Art Unit 3724 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

sc
October 24, 2001



KENNETH E. PETERSON
PRIMARY EXAMINER